



JPW 3723
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Docket Number 2004-3533

Patent

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Andrews, et al

Serial Number: 09/126,806

Examiner: Eileen P. Morgan

Filed: July 31, 1998

Group Art Unit: 3723

For: Rotary Dressing Tool Containing Brazed Diamond Layer

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Sir:

Amendment Under 37 CFR Section 1.111

This amendment is being filed in response to an office action mailed July 27, 2004, in the above-captioned patent application.

Claims 11-12 have been subjected to a restriction requirement and are withdrawn from consideration in the present application.

Claims 1-10, directed to a dressing tool with a layered rim, and designated as Group 1, stand rejected. Claims 1-3 and 8 stand rejected under 35 USC Section 102(b) over US Pat. No. 5,842,912 to Holzapfel, et al ("Holzapfel"). Claims 1-3, 6 and 8 stand rejected under 35 USC Section 102(a) over US Pat. No. 6,123,612 to Goers ("Goers"). Claims 4-7 and 9 stand rejected under 35 USC Section 103(a) over Holzapfel or Goers. No basis has been provided in the Office Action for the stated rejection of claim 10.

Applicants traverse the rejections.

REMARKS

For purposes of the prosecution record, Applicants note that neither the Holzapfel nor the Goers reference was published prior to the filing date of the present application and no evidence of the earliest invention date has been made of record for either reference or for Applicants' claimed invention. Thus, Applicants respectfully suggest that the rejections under Section 102(b) and 102(a), respectively, have failed to articulate a prima facie basis for rejection of Applicants' claims. In order to file a complete and timely response to the outstanding rejections, Applicants will